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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/665,984 | 09/19/2003 | Christopher McGee | 020375-042800US | 5376 |
| 20350 | 7590 | 10/20/2005 | EXAMINER | |
| TOWNSEND AND TOWNSEND AND CREW, LLP | | | LEE, DIANE I | |
| TWO EMBARCADERO CENTER | | | ART UNIT | |
| EIGHTH FLOOR | | | PAPER NUMBER | |
| SAN FRANCISCO, CA 94111-3834 | | | 2876 | |

DATE MAILED: 10/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

ELC

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|------------------------------|--------------------------------------|-------------------------------------|--|
| Office Action Summary | Application No. 10/665,984 | Applicant(s) MCGEE ET AL. | |
| | Examiner D. I. Lee | Art Unit 2876 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 July 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9,11,12,15-20,23-31,33-36,41-50,67 and 74-78 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9,11,12,15-20,23-31,33-36,41-50,67 and 74-78 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Receipt is acknowledged of the Amendment filed 22 July 2005. Claims 1, 12, 23, 31, 35-36, and 67 have been amended; claims 10, 13-14, 21-22, 32, 37-40, 51-66, and 68-73 have been canceled; and no claims have been newly added. Currently, claims 1-9, 11-12, 15-20, 23-31, 33-36, 41-50, 67, 74-78 are pending in this application.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

4. Claims 12, 15-20, 31, 33-34, 36, 41-42, 45-50, 67, 74, and 76-78 are rejected under 35 U.S.C. 103(a) as being unpatentable over Biller [US [2004,0182940 A1-referred as Biller] in view of what was well known in the art, as Admitted Prior by the Applicant [APA].

Re claims 12, 15-16, 19-20, 36, 41-42, 46, 49-50: Biller teaches the data card (a disc 20) and the method for displaying the card via display rack, which is functionally equivalent to display hook, the data card comprising:

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a data card (a disc 20) having an information storage medium (an encoding region having a magnetic stripe 70, a bar code, or any other suitable encoding) that is adapted to store a unique identifier (the encoding region comprising identification information associated with an account created for the purchaser) and at least one J-peg shaped aperture located on top side portion of the data card for suspending the data card from a display hook (a display hole 80 for hanging the data card on a display rack (not specifically shown) having a hook (not specifically shown)), and an additional circular aperture 110 through the data card (an aperture 110 to engage the disc to rotatable drive mechanism of an optical card reader) (see the abstract, paragraphs 31-33, 38, 43, and figures 1, 3-4 for example).

Biller does not teach the claimed dimension of the card (i.e., the card comprising rectangular shape having about $3 \frac{3}{8}$ inches by about $2 \frac{1}{8}$ inches having a live copy limit located on the front or back of the card at about $\frac{3}{32}$ of an inch from the top, bottom, and both side portion of the card).

However, Applicant admitted that the aforementioned card is a standard credit card size having a characteristics according to the known standard (i.e., CR80 standard), and wherein the standard credit card size with CR80 type card is known to have a rectangular shape having about $3 \frac{3}{8}$ inches by about $2 \frac{1}{8}$ inches and includes printed information on the front or back of the card, which obviously teaches that the card having a live copy limit located on the front or back of the card.

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate the known standard credit card size with CR80 type in the teachings of Biller in order to provide a standard credit card sized that user can easily carry in the user's wallet and to allow the card to be operable with a standard magnetic stripe reading

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device, thus providing the same standard card sliding movement of the card through a magnetic stripe reader.

With respect to the live copy limit located on the front or back of the card at about 3/32 of an inch from the top, bottom, and both side portion of the card, it would have been an obvious modification of the layout format of the printed formation of the card for an optimize the visual layout of the printed data on the card. Furthermore, it would have been an obvious matter of print format design choice of the printed information of the card, since such printed formation of the card would have involved a mere change of the print margin in the layout of the printed formation of the card. Such modification of the layout format of the printed formation of the card is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955).

Re claims 31 and 45: wherein the circular shaped data card has only one flat bottom edge and the information storage medium is located on the flat bottom edge of the data card (see figures 2 and 4) and wherein the at least one centrally spaced aperture 110 (i.e., as broadly interpreted by the examiner, "centrally spaced aperture" is any portion which lies with the perimeter of the card surface, since applicant has not specifically defined, in the claim language, that "centrally spaced aperture" must contain "the center point" of the card). Wherein the rectangular shaped portion has the information storage medium displayed thereon (see figures 4 and 7) and the diameter of the circular shaped portion is less than a longest length of the rectangular shaped portion (see figure 7).

Re claims 67, 74, 77-78: figure 4 shows the data card having at least one protrusion extends from one side portion of the data card (the figure 4 shows the protrusion extends from the top of the data card) and at least one semi-circular shaped like aperture through the

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protrusion for suspending the data card from a display rack, which is functionally equivalent to display hook.

Re claims 17-18, 33-34, 47-48, and 76: wherein the data card comprises a stored value card (i.e., the card contains information related to an account such as a prepaid or debit account that allows predetermined length of time to access the Internet, phone card, a gift card, or etc. (see the abstract, paragraphs 2, 12, 33, 43 for example).

5. Claims 1-9, 11, 43-44, and 75 are rejected under 35 U.S.C. 103(a) as being unpatentable over Biller in view of APA and Motoe [JP 2001-109859 A]. The teachings of Biller as modified by APA have been discussed above.

Although Biller as modified by APA shows at least one aperture located on a side/top portion of the data card for displaying data card on a display rack, and at least one display hole through the protrusion for hanging data card on a display rack; Biller as modified by APA does not teach the data card having a pair of apertures or a second protrusion with an additional aperture therethrough.

Motoe teaches the card having a plurality of holes for suspending the card from a binder.

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to provide more than one aperture on the card for displaying purpose in order to provide greater stability of placement of the card on the display rack and less likely for the card to fall off from the display rack.

With respect to each aperture of the card is at least about 1/16 of an inch from each other, it would have been an obvious matter of placement selection of the apertures, which directly depends on the placement of the binder ring. Thus, such placement of the aperture

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within the card body is generally recognized as being within the level of ordinary skill in the art.

In re Rose, 105 USPQ 237 (CCPA 1955).

6. Claims 23-30 and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Duroj [US 2004/0182940 A1] in view of Biller and APA. The teachings of Biller as modified by APA have been discussed above.

Re claims 23-25, 28-30: Duroj discloses a financial presentation instrument with an integrated holder comprising:

a rectangular shaped data card (a storage card 1, see par. 12) having an information storage medium (a circular partial segment 4, a magnetic field 5, bar codes 6, and a transponder 7, see pars. 12, 21, and figure 3) and at least one aperture (a hole 8 that is an elongated oval shape) therethrough for attached to a device (see par. 20 and figures 1-3), wherein the at least one aperture is located on a central portion (i.e., as broadly interpreted by the examiner, "a central portion" is any portion which lies with the perimeter of the card surface, since applicant has not specifically defined, in the claim language, that "a central portion" must contain "the center point" of the card); and an additional aperture (a circular aperture 3) through the data card (see figures 1-3).

Although the aperture of Duroj (i.e., the hole 8 that is an elongated oval shape that can easily adapted to place in a display rack), Duroj does not explicitly teaches that the aperture for suspending the data card from a display hook.

Biller as modified by APA discloses a data card having one J-peg shaped aperture (a display holder 80) therethrough for suspending the data card from a display hook in a display rack (i.e., the display hole 80 for hanging the data card on a display rack (not specifically shown) having a hook (not specifically shown)) (see par. 36 of Biller). Wherein the card is a known

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standard credit card size with CR80 type, which is known to include printed information on the front or back of the card.

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to utilize the aperture for suspending the card to display on a display rack, as taught by Biller as modified by APA in order to allow the data card to place in the display rack for retailing purpose.

With respect to the aperture the card is at least about 1/16 of an inch from the live copy limit and information storage medium, it would have been an obvious matter of selecting an optimum placement of the aperture in the body of the card without cutting out the printed information in the card and the information storage medium of the card. Thus, such placement of the aperture within the card body is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955).

Re claims 26-27: The data card comprises a stored value card and a gift card (see pars. 20, 24).

Re claim 35: Duroj fails to specifically teach the aperture having a rectangular shape.

However, Duroj states at paragraph 20 that the areas on the card that are not filled with information can be processed in any way chosen and anything is possible as long as it does not affect the possibility of placing the card in a reading device. Therefore, in view of Duroj's teaching, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to provide other shape of the aperture, such as a rectangular shaped aperture, to accommodate the hanging arrangement of the display rack. Therefore, providing the rectangular shaped aperture to the data card would have been obvious design variation of the aperture to accommodate the hanging arrangement of the display rack. Accordingly, it would have been an obvious extension, as taught by Duroj.

Response to Arguments

7. Applicant's arguments with respect to claims 1-9, 11-12, 15-20, 23-31, 33-36, 41-50, 67, 74-78 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

Pentz [US 6,471,127] and Warther [US 5,863,076] discloses a data card having an information storage medium one side and the live copy limit on the other side with at least one aperture therethrough for suspending the data card for display; and

Keller [US 6,196,594] discloses the characteristics of the CR 80 type standard credit card.

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to D. I. Lee whose telephone number is (571) 272-2399. The examiner can normally be reached on Monday through Thursday from 5:30 AM to 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on (571) 272-2398. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



D. I. Lee
Primary Examiner
Art Unit 2876

D.L.